

REMARKS

The Office Action mailed June 21, 2004 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

I. Summary of Rejections

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-5, 7, 10, and 23-26 are rejected under 35 U.S.C. §102(b) as being anticipated by British Patent Number 483028 to Grouven;
- Claims 1, 8, 10, 11, and 23-26 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 2,498,624 to Skinner;
- Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of U.S. Patent Number 5,896,682 to Lin and either of Grouven and Skinner; and
- Claims 1-26 are rejected under the doctrine of obviousness-type double patenting over the claims of U.S. Patent Number 6,684,532 to Greene, et al.

In addition, claim 25 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants submit that amendments to claim 25 overcome this rejection.

II. Summary of Claims

Claims 1-26 are currently pending in the application, with claims 1, 12, and 23 being independent claims. No claims are cancelled or added, and claims 1, 23, and 25 are amended, in accordance with the above amendments. Claims 2-22, 24, and 26 are unamended and remain, therefore, in their original, as-filed condition.

III. The Claims Patentably Distinguish Over The Applied Prior Art

Discussion of Independent Claim 1

Independent claim 1 recites various features of an article of footwear having an upper, foot-supporting member, and a sole structure. The upper covers at least a portion of a foot of a wearer. The foot-supporting member is removably-received by the upper and has a lower surface located opposite a foot-engaging surface. The lower surface is at a first elevation in a

forefoot region of the foot-supporting member, and the lower surface is at a second elevation in a heel region of the foot-supporting member. The second elevation is greater than the first elevation to define a recess below the heel region. The foot-supporting member also has a first thickness in the forefoot region and a second thickness in the heel region, the first thickness being greater than the second thickness. The sole structure is attached to the upper, and *the sole structure includes a polymer foam material at least partially located under the heel region of the foot-supporting member.*

Skinner discloses a removable insert for footwear having the form of a boot. In general, the footwear has a heel block situated in a heel region of the footwear and an outsole that extends from the forefoot region to a heel region of the footwear. Whereas the outsole forms the ground-engaging portion of the footwear in the forefoot region, the outsole extends above the heel block in the heel region. Accordingly, the heel block forms the ground-engaging portion of the footwear in the heel region. Grouven exhibits a similar structure.

Neither Skinner nor Grouven disclose suitable materials for the outsole or heel block. More particularly, neither Skinner nor Grouven disclose the use of a polymer foam material located under the heel region of the insert. Furthermore, the use of a polymer foam material in the sole of Skinner and Grouven is neither taught nor suggested by the structures of the soles disclosed in Skinner and Grouven. Accordingly, neither Skinner nor Grouven anticipate independent claim 1.

Based upon the above discussion, the Applicants submit that independent claim 1 is allowable over Skinner and Grouven. Similarly, dependent claims 2-11 should be allowable for at least the same reasons. In addition, claim 6 should be allowable over the combination of Lin and either Skinner or Grouven as Lin does not remedy the deficiencies of Skinner and Grouven discussed above.

Discussion of Independent Claim 23

Independent claim 23 also recites various features of an article of footwear having an upper, foot-supporting member, and a sole structure. The sole structure is secured to the upper, and the sole structure includes a foam material.

As discussed above, neither Skinner nor Grouven disclose suitable materials for the outsole or heel block, and the use of a foam material in the sole of Skinner and Grouven is

neither taught nor suggested by the structures of the soles disclosed in Skinner and Grouven. Accordingly, neither Skinner nor Grouven anticipate independent claim 23.

Based upon the above discussion, the Applicants submit that independent claim 23 is allowable over Skinner and Grouven. Similarly, dependent claims 24-26 should be allowable for at least the same reasons.

IV. Discussion of Double Patenting Rejection


Although the Applicants respectfully traverse the double patenting rejection on grounds that claims of the present application are patentably distinct from claims in U.S. Patent Number 6,684,532, a terminal disclaimer is filed herewith. The Applicants respectfully request, therefore, that the double patenting rejection be withdrawn.

V. Conclusion

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on September 22, 2004 with a one month extension of time and the terminal disclaimer. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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